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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,700	11/20/2003	Daniel R. Barelmann	0EKM-107845	1352

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/719,700	Applicant(s) BARELMANN ET AL	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12 and 20, drawn to a golf club/golf club shaft, classified in class 473, subclass 316.
 - II. Claims 13-19, drawn to a method of preparing a golf club shaft, classified in class 29, subclass 428.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions a golf club/shaft and a method of preparing a golf club shaft are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case a golf club/shaft can be made with a decal without using a heat transfer process.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Mr. Kyiacos Tsircou on 11 February 2005 a provisional election was made without traverse to prosecute the invention of a golf club/shaft, claims 1-12 and 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas in view of 0 433 843 and 11-206936.

Haas discloses a hollow sports device (Fig. 1) being made of a plurality of layers of prepreg (Abstract, [0029]), a hollow member having a primary cover [0047] and a heat transfer decal [0048].

Haas lacks a tubular golf club shaft having a butt end, a tip end, a longitudinal length, a tapered portion, a primary color along the majority of its length, a decal having a length of at least 5 % of the length, a decal having variable width profile, a first width along a first end of a decal toward the butt end of the shaft, a second width along a second lateral end toward a tip end, a first width being greater than a second width, first

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and second widths being less than about 5 % greater than the tubular member's outer circumference at the corresponding location, a decal having second, third, fourth and fifth colors including a band of a second color extending laterally 360 degrees about the tubular member at an end and longitudinally at least 6.5 mm at a location between first and second ends, a decal having at least one color covering the majority of the surface area, a portion of a pattern between first and second ends including a secondary color extending laterally 181 degrees or more and longitudinally at least 6.5 mm and third and fourth colors located laterally in the remaining 179 degrees or less, a head attached to a head at a tip end and a grip attached to a shaft at a butt end.

0 433 843 discloses a tubular golf club shaft (Fig. 7) having a butt end, a tip end, a head attached to a head at a tip end, a grip attached to a shaft at a butt end, a longitudinal length, a tapered portion (Fig. 11), a decorative layer over the entire surface of a shaft (DERWENT, Equivalent Abstract), a decal having variable width profile, a first width along a first end of a decal toward the butt end of the shaft, a second width along a second lateral end toward a tip end, a first width being greater than a second width (Fig. 3, DERWENT, Equivalent Abstract), first and second widths being less than about 5 % greater than the tubular member's outer circumference at the corresponding location (Fig. 7). In view of the reference of 0 433 843 it would have been obvious to modify the sporting device of Haas to be a tubular golf club having a butt end, a tip end, a head attached to a head at a tip end, a grip attached to a shaft at a butt end, a longitudinal length, and a tapered portion in order to utilize the benefits of the invention of Haas for a golf club. In view of the reference of 0 433 843 it would have been

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obvious to modify the golf club of Haas to have a primary color along the majority of its length prior to locating a decal in order to have the majority of a shaft the color of the primary color. In view of the reference of 0 433 843 it would have been obvious to modify the golf club of Haas to have a decal having a length of at least 5 % of the length, a decal having variable width profile, a first width along a first end of a decal toward the butt end of the shaft, a second width along a second lateral end toward a tip end, a first width being greater than a second width, first and second widths being less than about 5 % greater than the tubular member's outer circumference at the corresponding location in order to fit a decal along the profile of a tapered shaft without wasting decal material and in order to have graphics around the entire circumference of the shaft.

11-206936 discloses placing a decal on a shaft having multiple colors (DERWENT, Abstract, Solution). In view of 11-206936 843 it would have been obvious to modify the golf club of Haas to have a decal having second, third, fourth and fifth colors including a band of a second color extending laterally 360 degrees about the tubular member at an end longitudinally at least 6.5 mm at a location between first and second ends, a decal having at least one color covering the majority of the surface area, and a portion of a pattern between first and second ends including a secondary color extending laterally 181 degrees or more and longitudinally at least 6.5 mm and third and fourth colors located laterally in the remaining 179 degrees or less as a design choice of for using printed matter to create a decal, logo or graphics which is decorative and visually pleasing to a golfer.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haas in view of 0 433 843 and 11-206936 as applied to claims 1-10 and 20 above, and further in view of Ezawa.

Haas lacks a wood type head having a volume greater than 190 cc. Ezawa discloses a wood type head having a volume greater than 190 cc (Abstract; Fig. 1). In view of Ezawa it would have been obvious to modify the golf club of Haas to have a wood type head having a volume greater than 190 cc in order to have a wood head with decorative decals attached.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haas in view of 0 433 843 and 11-206936 as applied to claims 1-10 and 20 above, and further in view of Shiraishi.

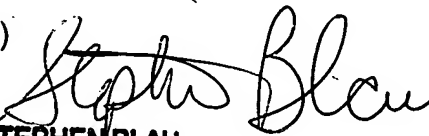
Haas lacks an iron-type head having a loft angle greater than about 18 degrees. Shiraishi discloses an iron-type head having a loft angle greater than about 18 degrees (Table 1). In view of Shiraishi it would have been obvious to modify the golf club of Haas to have an iron-type head having a loft angle greater than about 18 degrees in order to have an iron-type head with decorative decals attached.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson discloses decals (Col. 5, Lns. 40-68).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 13 February 2005


STEPHEN BLAU
PRIMARY EXAMINER